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DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK, NY 10150-5257

EXAMINER

THAI, HANH B

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/634,319	Applicant(s) ARIDOR ET AL.	
	Examiner Hanh B. Thai	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed 2/23/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 49-50, 58 and 62 is/are allowed.
- 6) ☒ Claim(s) 35-48, 51-57 and 59-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is Final Office Action in response to the amendment filed on February 23, 2007. Claims 1-34 have been canceled. Claims 35-62 are pending in this application.

Response to Arguments

1. Applicant's arguments with respect to claims 35-62 have been considered but have not been found persuasive.

Affidavit or Declaration Under 37 CFR 1.131

2. The declaration under 37 CFR 1.132 filed Jun 7, 2004 is insufficient to overcome the rejection of claims 1, 3-11 and 13-25 over De Bellis under 35 USC § 103 because: it does not establish conception and does not showing diligence for the appropriate period. The evidence submitted is not adequate to establish prior invention. It does not establish conception or reduction to practice prior to the date of the reference and does not show diligence for the appropriate period (see MPEP 715.07). Applicant submitted the declaration and it shows only two inventor's signatures.

I. Formalities: The declaration is improper in that it is not signed by all inventors

“The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint

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inventors are the sole inventor of the claim or claims under rejection.” (See MPEP 715.04)

II. Despite the improper execution, examiner will comment on the substance of the affidavit.

1. Applicant attempts to show prior invention by (A) reduction to practice prior to the reference date or, in the alternative, (B) by showing conception prior to the reference date combined with diligence from conception until filing of the application.

(A) Reduction to practice prior to the reference date:

2. The affidavit contains the following statement: “Applicants assert that the content of the attached invention Disclosure is sufficiently complete to form a constructive reduction to practice.”

3. This is an incorrect statement of the law. Filing of a US patent application which complies with the disclosure requirement of 35 USC § 112 constitutes a constructive reduction to practice. A written description, no matter how complete, which has not been made the subject of a US patent application does not qualify as reduction to practice.

(B) Applicant attempts to prove conception and then diligence.

CONCEPTION: It appears that applicant is relying on the September 26, 2000 disclosure statement to prove conception.

4. “Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that

conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.” (see MPEP 715.07).

“A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm’r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.” (See MPEP 715.07).

“The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what they are or when they occurred.”) (See MPEP 715.07).

5. In the affidavit applicant merely refers to the disclosure statement as a “constructive reduction to practice”. This amounts to a general allegation and does not

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meet applicant's burden of clearly explaining the exhibit "pointing out exactly what facts are established and relied upon by applicant"

6. The examiner has reviewed the disclosure statement and it appears that it may support conception in a properly executed affidavit. Which specifically points out what evidence is relied upon to establish conception.

DILIGENCE:

"In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established.

Ex parte Kantor, 177 USPQ 455 (Bd. App. 1958). »

7. Applicant has not established conception. However, in the interest of compact prosecution the examiner will address the affidavit with respect to diligence. Note that this is for guidance and is not necessarily comprehensive.

8. **"The critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131." (See MPEP 715.07 (a))"**

“The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975)”

“Diligence requires that applicants must be specific as to dates and facts; *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949)”

“An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.)”

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 35, 38-48, 51, 55-57 and 59-61 are rejected under 35 U.S.C. 102(b) as being anticipated by Liddy et al. (U.S. 6,304,864) in view of De Bellis (U.S. 6,760,720 B1).

Regarding claims 35, 51 and 59, a method for searching a corpus of documents, comprising:

- Defining a knowledge domain (column 3, lines 15-17 and lines 60-64, Liddy);
- Identifying a set of reference documents in the corpus pertinent to the domain (column 2, lines 5-8, Liddy);

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- Searching the corpus using the set of reference documents to find one or more of the documents in the corpus that contain information in the domain relevant to the first query (column 3, lines 56-60, Liddy).

Liddy, however, does not disclose adding at least one of the found documents to the set of reference documents for use in searching the corpus for information in the domain relevant to a second, subsequent query, which is substantially different from the first query. De Bellis discloses a search-on-fly search engine for searching databases including the focusing or refining the search (abstract and summary, De Bellis) reads on “adding at least one of the found documents to the set of reference documents for use in searching”. It would have been obvious to one of ordinary skilled in the art at the time the invention was made, to modify Liddy, as taught by De Bellis to derive the invention as claimed. The motivation of doing so would have been to provide an efficient system that can save time and expense involved in searching a very large amounts of data (col.2, lines 23-28, De Bellis).

Regarding claim 38, Liddy/De Bellis combination discloses the method wherein inputting the first query comprises specifying one or more documents representative of the information to be found in the corpus (col. 4, lines 29-36, Liddy).

Regarding claim 39, Liddy/De Bellis combination discloses the method wherein searching the corpus comprises searching the corpus to find the documents that contain the information relevant to the query and ranking the found documents by comparing them to the set of reference documents (col. 11, lines 27-35, Liddy).

Regarding claim 40, Liddy/De Bellis combination discloses method wherein ranking the found documents comprises evaluating a textual resemblance between the found documents and the reference documents (col.11, lines 27-35 and lines 9-14, Liddy).

Regarding claim 41, Liddy/De Bellis combination discloses the method wherein ranking the found documents comprises assessing links between the found documents and the reference documents (column 11, lines 46-50, Liddy).

Regarding claim 42, Liddy/De Bellis combination discloses the method wherein adding the at least one of the found documents comprises adding at least the document having the highest ranking (column 11, lines 42-46, Liddy).

Regarding claim 43, Liddy/De Bellis combination discloses in (Fig. 3A) the method wherein adding the at least one of the found documents comprises removing (70b) one of the documents from the set responsive to adding (70a) the at least one of the found documents (column 8, lines 43-49, Liddy).

Regarding claims 44 and 55, Liddy/De Bellis does not explicitly disclose the method comprising tracking a level of relevance of the reference documents to the queries, and wherein removing the one of the documents comprises removing one of the reference documents whose tracked level of relevance is low, but Liddy discloses the method of retaining the reference documents whose tracked level of relevant are high (column 11, lines 42-46). It would have been obvious to one of the skilled in the art to remove the low tracked level's relevance of the reference documents to enhance the language processor' speed.

Regarding claims 45 and 56, Liddy/De Bellis combination discloses the method wherein the corpus comprises at least a part of the World Wide Web, and the documents comprises Web

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pages, and wherein searching the corpus comprises conveying the query to one or more Web search engines (column 5, lines 57-67 and Fig 1, Liddy).

Regarding claim 47, Liddy/De Bellis combination discloses the method wherein identifying the set of reference documents comprises opening one or more files of a knowledge base on a computer in which data regarding the reference documents are saved (column 7, lines 37-56, Liddy).

Regarding claim 48, Liddy/De Bellis combination discloses the method wherein identifying the set of reference documents comprises identifying the set of documents used by a first user in searching the corpus, and wherein opening the one or more files comprises copying the files for use by a second user in searching the corpus for information in the domain (column 11, lines 27-36). Please note that the examiner regarding the files as reading on Liddy's "tables".

4. Claims 36-37 and 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liddy et al. (U.S. 6,304,864) in view of De Bellis (U.S. 6,760,720 B1) and further in view of Wical U.S. (6,038,560).

Regarding claims 36-37 and 52-54, Liddy/De Bellis combination does not explicitly disclose the method wherein searching the corpus comprises finding lexical characteristics of terms in the reference documents and refining the search terms using the lexical characteristics. Wical, however, discloses these lexical characteristics (column 2, lines 43-50, Wical). It would have been obvious to one of ordinary skilled in the art at the time the invention was made, to modify Liddy, as taught by Wical, to identify relevant terminology (column 2, line 60, Wical).

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5. Claims 46, 57 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liddy et al. (U. S. 6,304,864) in view of De Bellis (U.S. 6,760,720 B1), and further view of Bowman et al. (U. S. 6,006,225).

Regarding claims 46, 57 and 61, Liddy and De Bellis combination discloses all of the claimed limitation as discussed above, except the searching while the device is disconnected from the Web. Bowman, however, discloses these limitations on (column 2, lines 47-53, Bowman). It would have been obvious to one of the ordinary skilled in the art at the time the invention was made to modify the system of Liddy and De Bellis, as taught by Bowman, to allow the user to refine the query (column 2, lines 1-2, Bowman).

Allowable Subject Matter

6. Claims 49-50, 58 and 62 are allowed over the art of record.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to disclose or suggest "refining the search query using the lexical affinities of the query terms that were found in the reference documents".

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh B. Thai whose telephone number is 571-272-4029. The examiner can normally be reached on Mon-Thur (7:00AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

April 16, 2007

Hanh B Thai
Examiner
Art Unit 2163